



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,990	05/30/2001	Ryuichiro Maeyama	046601-5097	4511

9629 7590 10/30/2002

MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER

HAMPTON HIGHTOWER, PATRICIA

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/866,990

Applicant(s)

MAEYAMA ET AL.

Examiner

Patricia Hightower

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 and 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other:

***Information Disclosure Statement***

The information disclosure statement filed May 30, 2001 has been considered; however, the applicants did not submit a 1449 Form with the references cited.

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, drawn to a process for producing a heat resistant resin film having a metallic film, classified in class 264, subclass 176.1.
- II. Claims 3-14, drawn to a process for producing an endless belt having a metallic thin film, classified in class 205, subclass various.
- III. Claims 15-19, drawn to an endless belt having a metallic thin film, classified in class 428, subclass 458.

The inventions are distinct, each from the other because:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a laminate in gas, aroma, oxygen barrier layer or film. See MPEP § 806.05(d).

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product/endless belt having a metallic thin film can be made by a multilayer co-extrusion process,

Art Unit: 1773

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Mr. Douglas Rodriguez, Reg. # 47,269 on September 10, 2002 a provisional election was made without traverse to prosecute the invention of Group II, claims 3-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-2 and 15-19 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the

Art Unit: 1773

applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

The attempt to incorporate subject matter into this application by reference to Japanese Patent Application No. 2000-167835 filed June 5, 2000 at page 25, last line and page 26 lines 1-2 is improper because the incorporation of essential material in the specification by reference to a foreign application or patent or to a publication is improper.

### **35 USC 102 Rejection**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lam et al (USP 5,236,572).

Lam et al (USP 5,236,572) discloses a method for continuously manufacturing parts requiring precision micro-fabrication wherein according to the method, a surface of a mandrel having a reusable pattern thereon is moved through an electro forming bath, while the mandrel surface moves through the bath a metal layer is deposited on the mandrel surface to define a pattern after the metal layer has been deposited to the

Art Unit: 1773

selected thickness, the metal layer is separated from the mandrel surface; wherein the mandrel can be a movable belt or the mandrel can be a rotatable drum which anticipates the claimed invention. See abstract; col. 2, lines 10-46, 60-67; col. 3, lines 1-11, 12-67; col. 4, lines 1-67, the claims.

The patentee teaches at col. 2, lines 26 when the mandrel is a movable belt, the belt can be made of a sheet of polymer material such as polyamide having a metallized thin film such as titanium or chromium/titanium thereon forming the reusable pattern. Alternatively, the belt can comprise a sheet of electrically conductive material having a dielectric material such as silicon carbide, nitride or oxide thereon for defining the reusable pattern. When the mandrel is a drum, the drum can compromise an electrically conductive material such as stainless steel having a dielectric material thereon.

### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references are cited to show the state of the art of polyamide composition for polyamide/copper fact laminate, process for treating liquid crystal polymer film, image forming device, heat resistant resin film; Polan, Maeyama, Chen Jester and Kiktamura.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is 703-308-2434. The examiner can normally be reached on Monday - Friday from 9:30 A.M – 6:00 P.M.

Application/Control Number: 09/866,990  
Art Unit: 1773

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



P. Hightower/mn  
October 29, 2002

P. Hightower/mn  
Filing Clerk  
Art. 20.1.1.1